

REMARKS/ARGUMENTS

Status of the Claims

Claims 1 and 56-58 are currently amended.

Claims 3, 4, 7, 9, and 17-36 were previously canceled.

Claim 38 is currently canceled.

Thus, claims 1-2, 5-6, 8, 10-16, 37, and 39-58 are currently pending in this application.

Applicants hereby request further examination and reconsideration of the presently claimed application.

Claim Objections

Claim 38 was objected to on the basis of an informality. Applicants have canceled claim 38 rendering the objections moot.

Rejections under 35 USC § 103

Claims 1, 2, 5, 8, 10-16, 37, 39-41, 43-49, and 51-58 stand rejected under 35 USC § 103(a) as being unpatentable over Chatterji, et al., U.S. Patent No. 5,688,844 (hereinafter "*Chatterji*") in view of Krishnan, U.S. Patent No. 5,900,451 (hereinafter "*Krishnan*"). Claims 6, 38, 42, and 50 stand rejected under 35 USC § 103(a) as being unpatentable over *Chatterji* in view of *Krishnan* in further view of Griffith, et al., U.S. Patent No. 6,448,206 (hereinafter "*Griffith*"). Claims 1, 2, 5, 6, 8, 10-16, and 37-58 stand rejected under 35 USC § 103(a) as being unpatentable over *Griffith* in view of *Krishnan*. Claims 2, 5, 8, 10-16, 37, 39-41, 43-49, and 51-58 depend from independent claim 1 and, thus, stand or fall on the application of the combination of *Chatterji* and *Krishnan*, alternatively, the combination of *Chatterji*, *Krishnan*, and *Griffith*, alternatively, the combination of *Griffith* and *Krishnan*, to independent claim 1. As noted by the United States Supreme Court in *Graham v. John Deere Co. of Kansas City*, an obviousness determination begins with a finding

that “the prior art as a whole in one form or another contains all” of the elements of the claimed invention. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 22 (U.S. 1966). Applicants respectfully submit that the each of the cited combinations fails to contain all of the elements of independent claim 1 and, as such cannot render obvious the pending claims.

Amended claim 1 reads:

1. A method of servicing a wellbore in contact with a subterranean formation, comprising: placing a sealant composition comprising a colloiddally stabilized latex into the wellbore **and contacting the sealant composition with salts as it passes through the wellbore**, wherein the collodially stabilized latex comprises a protective colloid comprising polyvinylalcohol, a cellulose ether, a natural gum, a synthetic gum, polyacrylic acid, an acrylate, a poly(vinyl alcohol)co(vinyl amine) copolymer, or combinations thereof and **does not precipitate in a solution of at least 25 weight percent salt**.

See supra (Emphasis added). As shown above, independent claim 1 has been amended to recite the limitation ***contacting the sealant composition with salts as it passes through the wellbore***. Support for the amendment is found in the specification. *See* Application at [0026]. To the contrary, each of *Chatterji*, *Krishnan*, and *Griffith* is silent as to this limitation. As such, each of the combinations cited by the Office Action fails to contain all of the elements of independent claim 1, and therefore cannot render obvious the pending claims.

Second, Applicants submit that these combinations fail to contain the limitation that the colloiddally stabilized latex does not precipitate in a solution of at least 25 weight percent salt. As shown above, amended claim 1 recites the limitation that the colloiddally stabilized latex ***does not precipitate in a solution of at least 25 weight percent salt***. The Office Action suggests:

With respect to claim 1, *Chatterji* discloses a method of servicing a wellbore in contact with a subterranean formation, comprising: . . . wherein the colloiddally stabilized latex remains stable in a solution of at least 25 weight percent (wherein this would inherently happen as the composition of *Chatterji*’s stabilized latex emulsion is the same as that of Applicants; wherein the latex in *Chatterji* would inherently remain stable in the presence of salt because is stabilized by the third monomer mentioned in column 4 lines 55-64).

See Office Action at 2.

The Office Action suggests that this limitation is inherent in *Chatterji* because “the composition of Chatterji’s stabilized latex emulsion is the same as that of Applicants.” This assertion stands in contradiction to the Office Action’s recognition that *Chatterji*:

“ . . . does not disclose that the protective colloid comprises polyvinylalcohol, a cellulose ether, a natural gum, a synthetic gum, polyacrylic acid, an acrylate, a poly(vinyl alcohol)co(vinyl amine) copolymer, or combinations thereof.”

See Office Action at 2-3. As recognized by the Office Action, the instantly claimed sealant composition is not the same as *Chatterji*’s composition. Thus, the Office Action’s assertion that this limitation is inherent in *Chatterji* because “the composition of Chatterji’s stabilized latex emulsion is the same as that of Applicants” is in error. Specifically, the Office Action suggests that this limitation is inherent in *Chatterji* because it “is stabilized by the third monomer mentioned in column 4 lines 55-64.” “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is ***necessarily present*** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” See *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added). “Inherency, however, may not be established by probabilities or possibilities.” *Id.* “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* The Office Action has not shown why stability in the presence of salt is ***necessarily present*** in *Chatterji*. In particular, the Office Action has not shown why a composition having the third monomer recited at column 4, lines 55-64, would necessarily be stable in the presence of salt when the Office Action acknowledges that the specific protective colloids recited in claim 1 are not disclosed in *Chatterji*. Furthermore, it would not be obvious that such stability would result while contacting the sealant composition with salt as it passes through the wellbore, as recited in amended independent claim 1. As such, the Office

Action has not shown how the prior art contains this element. For the forgoing reasons, Applicants respectfully request withdrawal of the pending rejections and allowance of the claims.

CONCLUSION

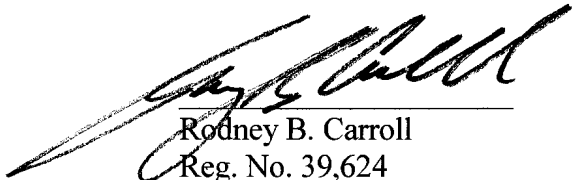
Consideration of the foregoing and reconsideration of the application, and withdrawal of the rejections are respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated January 8, 2009 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: _____

4-8-09


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